

REMARKS

This responds to the Office Action mailed on August 8, 2005, and the references cited therewith.

Claims 1, 22, 37, 50, 53, 63, 71-73, 83, and 92-94 are amended, claim 12 was previously canceled, without prejudice to the Applicant; as a result, claims 1-11 and 13-94 are now pending in this application.

§101 Rejection of the Claims

Claims 1-3, 13-22, 24-29, 37-42, 48, 71-72 and 83-91 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. At the outset Applicant continues to respectfully disagree with the Examiner's interpretation of the law with respect to these claims.

Essentially, the Examiner is rejecting these claims using two rationales. First, it is asserted that the claims fail the "technical arts" test. Second, it is asserted that limitations in the preamble cannot be imported to the claim bodies and therefore the preamble language is said to provide no limitation with respect to the language of the claim bodies. Applicant disagrees with both these rationales for the following reasons and respectfully asserts that the rejections cannot be sustained in the law and should therefore be withdrawn.

A very recent Board of Patent Appeals and Interferences case, *Ex parte Carl A. Lundgren* (Appeal No. 2003-2088; Paper No. 78; Application No. 08/093,516), addressed the "technical arts" test and addressed the cases that the Examiner has relied on directly in support of the "technical arts" test. Specifically, *Ex parte Lundgren*, which was designated as a "Precedential Opinion," stated unequivocally that there is "no technical arts test." *Ex parte Lundgren*, page 6, last sentence of first full paragraph : "[w]e have reviewed these cases and do not find that they support the examiner's separate 'technical arts' test." *Id.*

The very cases the Examiner has cited in support of the "technical arts" evaluation was reviewed in the *Ex parte Lundgren* case by the Board. The Board also determined that the Supreme Court specifically rejected the "technical arts" test by not addressing it and by not adopting it when it had the chance to do so. Moreover, the cited *Ex parte Bohman* case used by the Examiner is an unpublished opinion and the Board stated it cannot be cited as precedent and has not precedential value at all to the analysis. The Board stated that *Musgrave* did not create a

separate “technical arts” test. Furthermore, the *Musgrave* Court stated that for an invention to be deemed within the technical arts, all the claim has to do is promote the progress of “useful arts.” The Board also addressed *Toma*. In fact, each of the Examiner’s cited cases and rationale were addressed in this case and dismissed. The *Ex parte Lundgren* case actually permitted a manual practiced business method claim to be considered statutory even outside an embodiment of a computer, which is not the case in Applicant’s claims, because the examiner in *Ex parte Lundgren* determined the claim was useful, tangible, and concrete. Once that was done the analysis is over and the claim is statutory.

Applicant encourages the Examiner to review this precedential opinion of the Board. It is directly on point to the rejections of record in the present application and it is binding authority on the Patent Office and the Examiner. In fact, the Examiner has stated the claims are useful and produce a concrete and tangible result. See the Office Action bottom of page three and continuing to the top of page 4 where the Examiner states : “[i]n the present case the claimed invention generates and communicates a comment, thereby producing a useful, concrete, and tangible result, but not within the technical arts as explained above.” The last clause “but not within the technical arts” is not the law; and the Examiner is bound to follow the binding precedent of *Ex parte Lundgren* where it is clearly stated there is not a “technical arts” test and if a claim is useful, concrete, and tangible, then that claim is statutory.

Accordingly, with the Examiner’s first rationale for the rejections of the claims cannot be sustained and in fact must be withdrawn based on recent authority that the Examiner and the Patent Office are bound to follow.

The second rationale asserted by the Examiner is that a limitation as to structure in the preamble of a claim is not provided weight within the body of the claim language. In support of this claim, the Examiner cited *Bohman* and the MPEP. First, the *Ex parte Lundgren* Board made clear that *Bohman* carries no precedential weight and cannot be cited as authority as it was an unpublished opinion and the Board gave it no weight. Second, the Courts are the final arbiters on interpreting the laws and when it conflicts with the administrative rules of the MPEP, the MPEP is overruled by the law. Third, the cited MPEP section does not state that preamble limitations carry no weight when interpreting structure of the claim bodies. Applicant invites the

Examiner to provide the specific passage in MPEP 2106 IV 2(b) where this can reasonably be asserted as the Examiner appears to be alleging.

Furthermore, before this is even addressed by the Applicant, the Applicant would like to point out in view of the *Ex parte Lundgren* decision this rationale is no longer relevant. That is, once the Examiner determined that the claims were useful and produced a concrete and tangible result, the analysis is over and there are no further requirements such as the one being proposed here by the Examiner. Therefore, even though Applicant will demonstrate below that the Examiner's rationale is flawed in view of the present state of the law, the Applicant does not have to address this point since the analysis is concluded once the Examiner asserted the claims were useful and produced a concrete and tangible result.

Applicant asserts that the structures in Applicant's preambles are sufficient to provide structure for the claim bodies. Once again, the Examiner's attention is directed to MPEP 2111.02 "Effect of Preamble." Here it is stated: "any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." *Emphasis added*. Also see, *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1252, 1257 (Fed. Cir. 1989). There is little doubt that claims recite structure, namely "computer-implemented" and "machine-readable" and that this structure limits the positively claimed language of the rejected claims to computer implemented embodiments. The entire MPEP section 2106 discusses permissible software inventions, which include data structures where only the preambles of the data structures provide any structure. Structure is provided by way of the media and computer-implementation and that is a computer element, which the entire MPEP cites as permissible structure. The structure is sufficient if it resides solely in the preamble of the claim. The *Corning* case asserted this and the MPEP comports with the *Corning* case, and the MPEP is not contrary to this interpretation as the Examiner appears to be asserting.

Therefore, the rejections of record cannot be sustained in the law and in the administrative rules (MPEP) promulgated by the Patent Office. Applicant respectfully asserts that the Examiner is bound by this authority and has misapplied it in the present case. Accordingly, all the 101 rejections should be withdrawn because the Examiner has already admitted the claims are useful and produce concrete and tangible results. Once this was done, the Examiner admitted on the record that the claims were statutory and no further analysis was

appropriate and any further analysis was in fact contrary to the current state of the law.

Therefore, the rejections should be withdrawn.

§103 Rejection of the Claims

Claims 1-11, 17, 37-50, 53 and 57-72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuerst (U.S. 6,189,029) in view of Falk et al. (U.S. Publication No. 2001/0037206). It is of course fundamental that in order to sustain an obviousness rejection that each and every step or element in the rejected claims must be taught or suggested in the proposed combination of references. Moreover, the proposed combination of references must not be combined as the result of improper hindsight.

Fundamentally, the Falk and the Fuerst references are directed to different subject matter from what the Applicant's invention describes. That is, the references are specifically directed towards online surveys about goods and services. The surveys are not received from a user; rather a user is solicited to fill out a survey for a particular good or service. Moreover, a survey is a series of questions and is not a "predefined comment." In other words, a survey results in multiple answers to multiple survey questions and this is not the same as a single comment as is positively recited and limited in Applicant's amended independent claims.

The Applicant notes these distinctions to highlight for the Examiner that what the references are designed to achieve is fundamentally different from what Applicant's invention is designed to achieve. Applicant's claims positively recite limitations where a first user supplies a comment about second user and that comment expresses an opinion of the first user with respect to how an online transaction with the second user transpired from the perspective of the first user. This is not a series of questions and answers being supplied from a service to user about a good or service in order to derive how the user views the good or service. The invention directly receives an opinion from a first user about a second user, with respect to how the first user perceives the second user with respect to their joint online transaction.

The proposed combination of references fails to teach a comment selected by a first user that represents an opinion about the second user with respect to how an online purchasing transaction transpired between the first and second users from the perspective of the first user.

More specifically, the Falk reference is directed to surveying users about products the users purchased. The answers supplied by the users to the multiple questions associated with the surveys are directed to the products and not another user. The answers are not a single comment representing an opinion of a particular user about another user.

Similarly, the Fuerst reference is directed to customizing, submitting, and tabulating surveys and results of surveys. The survey answers are about a problem or are about a product, they are not about another user. Again, the answers do not represent a single comment reflecting an opinion of one user about another user.

It is clear that Applicant's invention facilitates generating a reputation history for an online buyer and/or seller because a comment is supplied from a first party (first user – buyer and/or seller) to an online transaction about a second party (second user – seller and/or buyer). The comment represents an opinion that the first party has about the second party as it relates to their joint online purchasing transaction. Conversely, the references, standing alone or in combination with one another, fail to teach or suggest building a reputation of a party to an online transaction. The references teach actively soliciting survey information about goods and services from buyers of those goods and services.

Additionally, the proposed combination of references could have only been assembled as a result of improper hindsight. That is, Falk proposes techniques for automatically generating questions and receiving answers from customers about goods and services; and Fuerst is directed to a tool that permits the questions or surveys to be generated, submitted, and analyzed. If one of ordinary skill in the art read Falk in view of Fuerst without having had the benefit of reading Applicant's disclosure then the result would be a tool that automatically generates, submits, gathers, and analyzes survey information about goods and services. This would not have led to gathering a comment submitted from a first user about a second user that reflects an opinion about that second user based on an online purchasing transaction that the two parties had with one another and from the perspective of the first user. Such a combination could have only been achieved by reading Applicant's disclosure and this would have been improper hindsight. Moreover, as detailed above, the combination would still lack a comment reflecting an opinion of the first user about the second user.

Therefore, the references, standing alone or in combination with one another, fail to teach each and every limitation of Applicant's amended independent claims and the combination formed in the manner proposed by the Examiner could only have been formed via improper hindsight. Accordingly, Applicant respectfully requests that the rejections be withdrawn and the claims allowed.

Claims 13 and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuerst in view of Falk et al. as applied to claims 1 and 53 above, and further in view of Harrington et al. (U.S. 6,161,099). Claim 13 is dependent from amended independent claim 1 and claim 54 is dependent from amended independent claim 53; therefore, for the amendments and remarks presented above with respect to independent claims 1 and 53, the rejections of claims 13 and 54 should be withdrawn. Applicant respectfully requests an indication of the same.

Claims 14-16, 18-25, 27-36, 51-52, 55-56 and 73-94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuerst in view of Falk et al. as applied to claims 1, 50 and 53 above, and further in view of Bayer et al. (U.S. 6,311,190). Again to sustain an obviousness rejection the proposed combination of references must teach or suggest each limitation in the rejected claims and the proposed combination must be properly constructed.

At the outset Applicant notes that claims 14-16, 18-21, 23-25, 27-36, 51-52, 55-56, 74-82, and 84-91 are dependent claims from amended independent claims; therefore, in view of the amendments and remarks presented herein with respect to those independent claims, the rejection of the claims 14-16, 18-21, 23-25, 27-36, 51-52, 55-56, 74-82, and 84-91 should be withdrawn. Applicant respectfully requests an indication of the same.

Accordingly, the remarks presented with this rejection are related to independent claims 22, 73, 83, and 92-94 and made in view of the amendments to these claims presented above. The Examiner is reiterating the rejections of the independent claims enumerated above, which were rejected on the basis of the proposed Falk-Fuerst combination, and further relies on Bayer for teaching the communication of a comment to a requestor. Therefore, the extent to which this rejection overlaps the discussion of the Falk-Fuerst combination, the remarks presented above

are incorporated by reference herein with these rejections and Applicant respectfully submits that the combination still fails to teach a comment representing an opinion of a first user about a second user with respect to an online transaction occurring between the first and second users.

Bayer is directed to techniques for conducting surveys in different languages over a network. Bayer translates a survey, which again comprises a series of questions, in multiple target languages and gathers answers in the target languages. The results are assembled in a desired language and can be presented in that desired language or in each of the target languages. This reference still fails to gather a single comment from a first user about a second user that reflects an opinion of the first user about the second user.

Therefore, the rejection with respect to the proposed combination of references fails to teach each and every limitation of the amended independent claims. Correspondingly, the rejections should be withdrawn and the Applicant respectfully requests that the claims be allowed.

Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuerst in view of Falk et al. and further in view of Bayer et al. as applied to claim 22, and further in view of Harrington et al. Claim 26 is dependent from amended independent claim 22; thus, for the amendments and remarks presented above with respect to independent claim 22, the rejection of claims 26 should be withdrawn. Applicant respectfully requests an indication of the same.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 513-942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

BARRY BOONE

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
513-942-0224

Date 11-8-05

By Joseph P. Mehrle
Joseph P. Mehrle
Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 8 day of November, 2005.

Peter Rebuffoni
Name

Peter Rebuffoni
Signature